

Mailed: September 9, 2003
Paper No. 9
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Sherwin-Williams Company

Serial No. 78/070,590

Vivien Y. Tsang for The Sherwin-Williams Company.

Cheryl Clayton, Trademark Examining Attorney, Law Office
102 (Thomas V. Shaw, Managing Attorney).

Before Hanak, Hairston and Holtzman, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

The Sherwin-Williams Company has filed an application
to register the mark PAINTER'S PREFERRED for "caulking and
adhesive sealants for general use."¹

The Trademark Examining Attorney has finally refused
registration under Section 2(e)(1) of the Trademark Act, 15
U.S.C. §1052(e)(1), on the ground that applicant's mark is
merely descriptive of its goods.

¹ Serial No. 78/070,590, filed June 22, 2001, alleging dates of
first use of June 28, 2000.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but no oral hearing was requested.

The Examining Attorney contends that,

... when applied to the [a]pplicant's goods, the mark, PAINTER'S PREFERRED, immediately describes without any exercise of imagination, mental processing or gathering of further information, the merely descriptive significance of the wording as it relates to the quality, use and purpose of the [a]pplicant's goods as used by and preferred by painters who know the quality [of] products.
(Brief, p. 5).

In support of the refusal, the Examining Attorney made of record third-party registrations that include the disclaimed word "PAINTER" for paint and related products. Also, she made of record third-party registrations that include the word "PREFERRED," which issued on the Supplemental Register or under the provisions of Section 2(f), or with a disclaimer of "PREFERRED, for various goods and services.

Applicant, in urging reversal of the refusal to register, argues that the mark PAINTER'S PREFERRED is at most suggestive of the identified goods; that the word "PREFERRED" does not describe any specific characteristic or quality of the goods; and that any doubt regarding descriptiveness should be resolved in applicant's favor.

Applicant made of record third-party registrations of marks that include the words "PAINT" or "PREFERRED," which issued on the Principal Register with no Section 2(f) claim or without a disclaimer of the words "PAINT" or "PREFERRED."

A term is merely descriptive, and therefore unregistrable pursuant to Section 2(e)(1), if it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the goods with which it is used. In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). On the other hand, a term which is suggestive is registrable. A suggestive term is one which suggests, rather than describes, such that imagination, thought or perception is required to reach a conclusion as to the nature of the goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). There is but a thin line of distinction between a suggestive and a merely descriptive term, and it is often difficult to determine when a term moves from the realm of suggestiveness to the sphere of impermissible descriptiveness. In re Recovery, Inc., 196 USPQ 830 (TTAB 1977).

Applying these principles to the evidence of record, we conclude that PAINTER'S PREFERRED has not been proven to be merely descriptive of caulking and adhesive sealants for

general use. The mark only suggests that applicant's goods are of high quality because they are "preferred" by painters. Some thought or perception is required to draw this conclusion concerning the nature of applicant's goods.

Although we have considered, of course, the third-party registrations introduced by the Examining Attorney, we are not persuaded to reach a different result in this case. Such registrations tend to show that in the past, the Trademark Examining Operation has viewed the word "PAINTER'S" to be merely descriptive when applied to paint and related products and the word "PREFERRED" to be merely descriptive for various goods and services when "PREFERRED" modifies the name of the goods or services. For example, PREFERRED LEGAL PLAN is registered on the Supplemental Register for legal services; PREFERRED HOMEBUYERS PROGRAM is registered on the Principal Register under Section 2(f) for mortgage lending and real estate agency services; VIP PREFERRED CARD is registered on the Principal Register for check cashing services with a disclaimer of "PREFERRED;" and PREFERRED BLEND and design is registered on the Principal Register for wild bird food and wild bird seed with a disclaimer of "PREFERRED BLEND."

Of course, in this case, the mark sought to be registered is PAINTER'S PREFERRED, not PREFERRED CAULKING AND ADHESIVE SEALANTS, and thus applicant's mark is somewhat different from the marks in the third-party registrations submitted by the Examining Attorney.²

Finally, we recognize that we must resolve whatever doubt we may have regarding the merely descriptive character of the mark in favor of applicant and the mark should be published for opposition. In re Rank Organization Ltd., 222 USPQ 324, 326 (TTAB 1984) and cases cited therein.

Based on the record before us, we conclude that the mark PAINTER'S PREFERRED, when applied to caulking and adhesive sealants, is not merely descriptive.

Decision: The refusal to register under Section 2(e)(1) is reversed.

² On the other hand, applicant's mark is more akin to the marks in the third-party registrations submitted by applicant. For example, the following marks registered on the Principal Register with no claim of Section 2(f) and no disclaimer of the word "PREFERRED": EMPLOYEE PREFERRED for banking services; SENIORS' PREFERRED for moisturizing lotions and creams; ACCOUNTANTS PREFERRED for staffing services specializing in accountants; and HOMEBUYERS PREFERRED for a radon protection plan.